

In Section 1 on page 2 of the office action, claims 1-59 are said to be rejected on the ground that they “recapture claimed subject matter deliberately canceled in application serial Number 07/978,272.” Presumably, this rejection is not intended to apply to original claims 1-27, but only to new claims 28-59. Original claims 1-27 were never canceled and are contained in Patent No. 5,418,537, which the present application seeks to reissue.

In support of the rejection (of claims 28-59) the Examiner compares claim 28 in this application to claim 31 canceled from the original application and concludes that claim 28 is “broader in all aspects” (Office action , page 4). The Examiner’s contention regarding the relative scope of the claims presented in this application and the claims canceled from application serial No. 07/978,272 is respectfully traversed. Each of independent claims 28-33 added in the present application calls for a paging request responder and a communications device separate from, and for operation independent of, the paging request responder, or a method employing such devices (see claim 28 as amended and the similar recitations in claims 29-33). New claims 50-59 specify either that feature or a noncellular paging request responder and a cellular communications device or a method employing such devices, or the feature that the communications device is for operation independent of the paging request responder, or a method employing such a communications device. Neither claim 31 nor any other claim canceled from Application Serial No. 07/978,272 contains such limitations.

That difference between the claims presented in this application and the claims presented in Serial No. 07/978,272 was pointed out in the amendment filed January 27, 2000. In the outstanding office action, the Examiner appears either to take issue with that characterization of the difference or to believe that that difference is irrelevant. The Examiner states (page 4 of

the Office action):

. . . claim 31 in the patent application was canceled (combined with claim 10 to form allowable claim 39, renumbered as claim 7). Comparing new claim 28 to canceled claim 31; it is broader in all aspects[.] The patented claim 7 required the subject matter of claim 10 to be allowable. Therefore, Applicant “surrendered” claimed subject matter not including the limitations of claim 10.

Applicant respectfully disagrees that he surrendered all claimed subject matter that does not include the limitations of canceled application claim 10. Canceled application claim 10 specifies the step of choosing a vehicle location receiver/processor to be a LORAN signal receiver/processor that receives time-coded LORAN signals from a plurality of LORAN signal transmitters and determines the vehicle location from the signals. While those features in combination with the other features of patent claim 7 define patentable subject matter, that in no way implies that every patentable claim must include the features of canceled application claim 10. We need only examine claim 1 of the patent to find proof of that.

Nor does a failure to include the limitations of canceled application claim 10 in reissue claim 28 imply recapture. The Examiner states on page 5 of the Office action that, to avoid recapture, all reissue claims must retain at least one of the reasons (limitations) which made the patent claims allowable. All of the reissue application claims meet the Examiner’s test, since all recite, for example, paging requests, transmission of fixes, etc. It is incorrect to single out any one limitation and say that that particular limitation made the claim allowable. The limitation singled out will in almost every case be known in the prior art and unpatentable per se. What a patent claim protects is the combination of all of the features it recites. Thus claim 7 of the patent does depend on a recitation of LORAN signals for patentability, but it equally depends for

patentability on a recitation of providing a page responder, as recited at patent column 14, line 16, a recitation of "causing the controller/modem to cause the cellular telephone to contact a selected vehicle location service or paging service and to communicate the information on the vehicle present location to the vehicle location service or paging service," as recited at patent column 14, lines 40-44, etc.

On the other hand, patent claim 1 does not depend for patentability on a recitation of LORAN signals. Instead, it depends for patentability on a recitation of GPS signals, among other features.

There is no deconstruction of the claims and their file history which makes it possible to say that the claims in this reissue application, in order to be patentable, must include the recitations of canceled claim 10 of the original application.

The correct recapture analysis is to inquire whether the claims in the reissue application include some (read any) narrowing limitation not present in the claims deliberately canceled in the original application. The new reissue claims contain limitations (described above) that make them narrower in a material respect than the claims canceled from application serial No. 07/978,272. This is easily confirmed in the case of new claim 28 and canceled claim 31 singled out by the Examiner on page 4 of the Office action. Claim 38 canceled from the original application does not exclude the case where the communications device is integrated with the paging request responder. New claim 28 of the present application does exclude that case. Since one can easily imagine, for example, a cellphone and a pager combined as a single unit, the exclusion (narrowing limitation) is not incidental or mere verbiage.

The Examiner may feel instinctively that new claim 28, for example, is somehow broader


"overall" than canceled claim 31. However, such an instinctive feeling regarding the "overall" breadth of a claim is not a proper substitute for an analysis made in accordance with the controlling case law. If a claim in a reissue application is broader in one respect and narrower in another respect than a claim canceled from the original application, and if the narrowing limitation has a material aspect to it, then the relationship between the claims is that of intersecting Venn diagrams, where each diagram encloses an area that lies outside the other, and there is no recapture.

The applicant does not seek to recapture in this application any subject matter canceled from the parent application. While the claims in this application are broader than those canceled from the parent application in certain respects, they are narrower in another respect.

It is respectfully requested therefore that the Examiner reconsider and withdraw the final rejection and issue a formal Notice of Allowance.

Applicant has already submitted original letters patent No. 5,418,537 in response to the ex-parte Quayle communication mailed August 9, 1999.

Respectfully submitted,
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